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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,047	12/02/2003	Aakash Bordia	260-002	2682
44185	7590	11/16/2007	LOT9-2003-0099US1	
LOTUS AND RATIONAL SOFTWARE McGuinness & Manaras LLP 125 NAGOG PARK ACTON, MA 01720			EXAMINER SING, SIMON P	
			ART UNIT	PAPER NUMBER
			2614	
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			11/16/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/726,047

Applicant(s)

BORDIA, AAKASH

Examiner

Simon Sing

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments that Ellendman fails to teach a source server and a destination server, see pages 5-7 of the Appeal Brief, filed on 7/28/2007, with respect to claims 1-20 have been fully considered and are persuasive. The final rejection of claims 1-20 has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made in view of Kulkarni US patent Publication No. 2004/0093382.

2. Applicant's arguments that Ellendman fails to teach transferring an exclusion list to any system other than a client system have been fully considered but they are not persuasive, because such limitation was not recited in the claims.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant claims: "assigning, by a source server system, a difference between said include set of recipient entities and said exclude set of recipient entities;

Art Unit: 2614

determining, by a destination server system, a result of a difference operation between said include set of recipient entities and said exclude set of recipient entities". As claimed, the result of a difference operation is obtained from the assigning step in the source server system. Since there is only one difference between said include set of recipient entities and said exclude set of recipient entities, it is unclear in the claims whether the destination server system determines (a) the result of a difference operation from the assigning step performed by the source server system, or (b) the result of difference operation performed by the destination server system. In the specification, the difference operation is performed by either a source system or a destination system in different embodiments (figures 4 and 5; page 10, line 18 to page 12, line 14). Therefore, in the following office action, examiner interprets the claims according to the specification that the difference operation is performed by *either* a source system *or* a destination system.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellendman US 2003/0048298 in view of Kulkarni US 2004/0093382.

Art Unit: 2614

4.1 Regarding claims 1, 7, 13, 19 and 20, Ellendman discloses a method, system and computer program for sending an e-mail message to a list of recipients with exclusions, comprising:

determining at least one include set of recipients, such as OrgList, ExecCommList, and MediaList in recipients fields 21-23 (figure 2);

determining at least one exclude set of recipient in remove fields 24 and 26-28 (figure 2);

assigning, by a source system (a user device, such as a computer, connecting to an email system for composing and sending an email message, the user device is part of the source system) at least a difference set of recipients between the at least one included set and the at least one exclude set of recipients (paragraph 0016-0028).

Ellendman is silent on a source server and a destination server for determining the result of the difference operation in the assigning step.

However, it is obvious that when receiving incoming e-mail messages, a destination e-mail server determines the recipients' addresses (a result of difference operation in the assigning step) in the messages' headers against recipients' mailbox addresses in order to deposit the messages accordingly.

In addition, Kulkarni teaches user client 13 connecting to a source server system 10a. The source server 10a determines each recipient's address in both a distribution list and an exclusion list, and sends the distribution list and the exclusion list to a destination server system 10b. The destination server system 10b performs a difference operation between the distribution list and the exclusion list, and determines

Art Unit: 2614

the result of the difference operation in order to deposit a message into each recipient's mailbox (paragraphs 18, 27-38).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Ellendman's reference by the teaching of Kulkarni, so that the source system would have comprised a server, and a distribution list and an exclusion list would also have been sent to the destination server system, because such a modification would have clarified that the source system comprised a server, and would have enabled a difference operation, to exclude recipients in a exclusion list, to be performed by either a source server system or a destination server system.

4.2 Regarding claims 2, 8 and 14, Ellendman teaches a carbon copy (Cc) address filed 22 in figure 2.

4.3 Regarding claims 3, 9 and 15, Ellendman teaches a blind carbon copy (Bcc) address filed 23 in figure 2.

4.4 Regarding claims 4, 10 and 16, Ellendman teaches a distribution list including an OrgList which is an organization list in field 21 and an associated remove list in filed 26 (figure 2; paragraphs 0016-19), and the modified Ellendman system teaches performing a difference operation in either the source server system or the destination server system as stated above.

Art Unit: 2614

4.5 Regarding claims 5, 11, and 17, Ellendman teaches a ExecCommList (second list) in field 22 and an associated remove list in field 27 (figure 2; paragraph 0020-0023), and the modified Ellendman system teaches performing a difference operation in either the source server system or the destination server system as stated above.

4.6 Regarding claims 6, 12, and 18, Ellendman teaches a MedialList (third list) in field 23 and an associated remove list in field 28 (figure 2; paragraph 0024-0028).

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Simon Sing whose telephone number is 571-272-7545. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.



S. Sing

11/02/2007